## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:     Jonathan Dale

Serial No:               10/608,876

Date Filed:              June 27, 2003

Group Art Unit:          3628

Examiner:                Fadey S. Jabr

Confirmation No.         7466

Title:                   DYNAMIC SERVICE SCHEDULING

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

### PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

## REMARKS

Applicant requests review of the rejections to the Application outstanding in the Final Office Action transmitted September 15, 2008 (*"Office Action"*) and the Advisory Action dated December 29, 2008 (*"Advisory Action"*). Claims 1-31 are pending in the Application, and the Examiner rejects all pending claims. As the rejections contain clear factual and legal deficiencies, Applicant respectfully requests review and favorable action in this case.

### I.    Rejection Under 35 U.S.C. § 101

The Examiner rejects Claims 11-20 under 35 U.S.C. § 101 because computer programs are claimed as computer listings *per se,* i.e., the descriptions or expressions of the programs, are not physical "things." *Office Action,* p. 3. With respect to Claims 11-20, the *Office Action* maintains that "an *interface* and an *agent* are considered to be software and are therefore deemed to be non-statutory." *Advisory Action; Office Action,* p. 3. Applicant notes that Claim 11 is not directed to a process or computer software, but rather is directed to a "consumer system" that includes, at a minimum, a database, an interface, and an agent. Applicant respectfully submits that the *Office Action* improperly applies standards for process claims with respect to this system claim. Also, Applicant notes that the *Office Action* only addresses the interface and agent elements, while ignoring the fact that this is a "system" claim that also includes a database. Even if some elements of the claim could be implemented using software, that does not render the claim ineligible under § 101, as the claim is directed to a system and contains more than the two elements addressed by the *Office Action.* Moreover, as detailed in the specification, the interface and agent elements rejected by the *Office Action* are "incorporated in and/or provided by any suitable network accessible equipment." Specification, p. 12. The claimed interface and agent are therefore tied to a machine within the meaning of § 101 because they are incorporated in network accessible equipment. Applicant therefore respectfully submit that the rejections of Claims 11-20 contain clear factual and legal deficiencies.

### II.    Rejection Under 35 U.S.C. § 103

The Examiner rejects Claims 1-31 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2008/0010105 issued to Rose et al. (*"Rose"*) in view of U.S. Patent Application Publication No. 2006/0287897 issued to Sobalvarro, et al. (*"Sobalvarro"*). Applicant respectfully traverses the rejection and submits that *Rose* and

*Sobalvarro*, whether taken alone or in combination, fail to teach or suggest each and every limitation of the claims.

Consider Applicant's independent Claim 1, which recites:

> A method for dynamic service scheduling comprising:
> identifying a template specifying a plurality of events;
> determining a plurality of consumer descriptors;
> accessing a remote service directory having service descriptors for each of a plurality of services;
> filtering the services from the service directory based on the service descriptors, the events, and the consumer descriptors to determine potential ones of the services for fulfilling the events;
> querying each of the potential services for additional service descriptors;
> filtering the potential services based on the additional service descriptors, the events, and the consumer descriptors to determine selected ones of the services for fulfilling the events;
> identifying service links for accessing the selected services;
> modifying the template to associate the service links with the events;
> determining whether each of the events in the template has an associated service link; and
> when each of the events in the template has an associated service link, presenting the template for acceptance.

Among other aspects, *Rose* and *Sobalvarro*, whether taken alone or in combination, fail to teach or suggest: (1) identifying a template specifying a plurality of events; and (2) modifying the template to associate the service links with the events, as Claim 1 requires.

**A.     The proposed combination fails to teach or suggest identifying a template specifying a plurality of events.**

Claim 1 requires identifying a template specifying a plurality of events. Applicant's specification describes the claimed template as a tool for scheduling services to fulfill the events that is refined over a series of one or more iterations. Specification, p. 8. As teaching the claimed template, the *Office Action* continues to point to *Rose,* figures 5A and 6A. *Advisory Action*; *Office Action*, p. 2. *Rose's* figure 6A teaches a web home page for the restaurant super-community that allows an internet user to search restaurants by submitting a search request. *Rose*, ¶¶ 55-56. In particular, the *Advisory Action* argues that *Rose's* web home page for restaurants "discloses a template where a user chooses a restaurant and uses the system to book the reservation." *Advisory Action*. Given that Claim 1 requires a template specifying events, and *Rose's* web page lists restaurants, Applicant assumes that the Examiner points to *Rose's* restaurants as teaching the claimed events. *Rose's* restaurants,

however, cannot teach "events" as recited by Claim 1. Accordingly, *Rose* fails to teach or suggest "identifying a template specifying a plurality of events," as Claim 1 requires. *Sobalvarro* fails to remedy the deficiencies of *Rose*.

> **B.    The proposed combination fails to teach or suggest modifying the template to associate the service links with the events.**

Claim 1 requires "modifying the template to associate the service links with the events." As teaching these aspects, the *Office Action* points to *Sobalvarro*, Abstract and paragraph 100, and argues that "*Sobalvarro* teaches dynamic packaging of perishable items such as travel goods and services. ... Further Sobalvarro teaches this more descriptive display outlines the various components within the package . . . and may give the consumer the option of adding on optional components." *Office Action*, p. 3. In the Abstract, *Sobalvarro* explains that its products or services are grouped according to an affinity algorithm and may be "reviewed and approved or selected by human operators using the back end interface before being offered for sale on the sales interface." Abstract. In paragraph 100, *Sobalvarro* teaches that its package displays may give the consumer the option of adding on optional components. ¶ 100. The *Office Action's* argument, however, still does not change the fact that *Sobalvarro*'s package offerings as outlined on the descriptive display are fixed and cannot be modified. Accordingly, *Sobalvarro*'s package offerings fail to teach or suggest modifying anything, much less "modifying the template to associate the service links with the events," as Claim 1 requires. *Rose* fails to remedy the deficiencies of *Sobalvarro*.

Even assuming, for argument's sake, that *Sobalvarro* were to suggest modifying its package offerings, the *Office Action* still does not present a legally sufficient argument demonstrating obviousness. Since the *Office Action* relies on *Rose*'s web page as teaching the claimed template, *Sobalvarro* would have to teach modifying *Rose*'s web page for the *Office Action's* rejection to stand; there is no such teaching. Both the *Office Action* and the *Advisory Action* fail to provide any reason for modifying *Rose's* web page to include *Sobalvarro's* package offerings. In fact, Applicant submits that it would be illogical to modify *Rose's* template to include *Sobalvarro's* package offerings, as the combination would render *Rose's* template inoperable. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Further, the

Federal Circuit has repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. *See, e.g., Grain Processing Corp. v. American Maize-Products,* 840 F.2d 902,907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Independent Claims 11, 21, and 31 include limitations that, for substantially similar reasons, are not taught by *Rose* and *Sobalvarro*. Because *Rose* and *Sobalvarro* do not teach or suggest every element of independent Claims 1, 11, 21, and 31, Applicant respectfully submits that the rejections of Claims 1, 11, 21, and 31 and their respective dependent claims contain clear factual and legal deficiencies.

## CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of this Application.

If the Examiner feels prosecution of the present Application may be advanced by a telephone conference, Applicant invites the Examiner to contact the undersigned attorney at (214) 953-6584.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant

Kurt M. Pankratz
Reg. No. 46,977

Date:   January 15, 2009

Customer No. **05073**